

## **Response to Claims Rejections.**

### **Rejection of claim 5 under 35 U.S.C. §112.**

The Examiner has rejected Claim 5 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts “Re claim 5: the limitation, “the second person” in line 3 lacks clear antecedent basis.” Applicant respectfully traverses such rejection for the following reason:

Claim 5 is dependent of dependent claim 2, which provides, “2. The novelty kit of claim 1 wherein the first substance has an identifiable taste.” Claim 1 states, *inter alia*, “... b) instructions for use of the first substance with a second person.” (Emphasis added.) Clearly there is an antecedent basis for the “second person” of claim 5.

### **Rejection of claims 1 and 5 under 35 U.S.C. §102.**

The Examiner has rejected Claims 1 and 5 under 35 U.S.C. §102 as being anticipated by Guess the Flavor (Kissing Games). Applicant strenuously objects to this reference. Such reference was extracted from the website VirtualKiss.com. The copyright notice of such reference states, “All content © 1996-2001 Virtual Kiss.com, all rights reserved.” Accessing the VirtualKiss website reveals at least 18 menu items regarding kissing topics. There is absolutely no way of determining or substantiating that the kissing game described in the reference cited by the examiner predates by one year the application for patent of the Examiner. Applicant requests that the Examiner provide substantiation of the existence of the cited reference prior to August 21, 2002, or withdraw the rejection based on this reference.

Additionally, Examiner asserts that the reference discloses the invention. The Examiner states:

“Re claims 1 and 5: Guess the Flavor discloses a novelty kit for producing an oral sensation during deep kissing, the novelty kit comprising a first substance/*various candy* to be placed on the tongue of a first person; and instructions / *How to play* for use of the first substance with a second person; additionally comprising a second substance / *food items* and wherein the instruction include directions for the use of the first substance and the second substance by the first person and the second person.”

Applicant respectfully traverses the Examiner’s rejection for the following reasons:

First, the reference does not disclose a novelty kit. In fact, the cited reference teaches away from the concept of a kit. The second paragraph of the reference is titled, “Things you’ll need.” Included in such paragraph are all of items necessary to play the game. None of the items are furnished as part of a kit. Instead, the participants are expected to individually purchase the items. The only thing provide by the reference is the instructions, not a kit.

Second, the cited reference does not disclose an oral sensation as described in Applicant’s specification. Applicant, at page 1, line 15 describes the taste sensation thusly, “The taste buds are stimulated by four fundamental taste sensations: sweet, salty,

sour, and bitter.” The cited reference does not use the word, “sensation,” nor does the cited reference describe any of the fundamental taste sensations. Instead, the whole purpose of the game in the cited reference is to identify a particular food/candy that was eaten.

Third, the Examiner asserts that the participants in the cited reference additionally comprises a second substance / *food items*. Applicant believes that the examiner is misreading the teaching of the reference. While it is true that a substance to be tasted can include food items, it is clear that only one kind of food or candy is to be eaten prior to the game being played, therefore only one food/candy to be identified. There is no teaching of detecting a “sensation” as claimed by the Applicant.

Fourth, the cited reference describes a game in which various food items are to be eaten by one set of participants, the identity of such food item to be guessed by a second set of participants. Nowhere in the claims of Applicant’s application are the participants directed to eat any food item. In fact, the only direction by Applicant is that a first substance to be placed on the tongue of a first person. Consuming the substance is not contemplated.

The Examiner then states, “[i]t is inherent to the Examiner that to guess the flavor of substances, there has to be identifiable taste associated with the substance.” This statement is totally irrelevant to the invention of the Applicant. Identifying a particular food or candy is not claimed by Applicant. Applicant respectfully traverses such statement, particularly to the use of the word “inherent.” Under the doctrine of inherency, “[a]nticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references.” *In re Felton*, 484 R.2d 495, 500, 179 USPQ 295, 298 (CCPA 1973). Under the Doctrine of Inherency, inherency does not mean that a thing might happen, the desired result **must inevitably happen** for the doctrine to apply. *Kropa v. Robie and Mahlman*, 88 U.S.P.Q. 478 (C.C.P.A. 1951). (Emphasis added.) Therefore, under the doctrine of inherency, the tasting of any food/candy must result in the detection of a taste sensation as defined and claimed by applicant. Therefore, Applicant need only show one food/candy, when placed on the tongue, does not result in a taste sensation of sweet, salty, sour, and/or bitter. There are many foods/candies which do not leave a taste sensation, one of which is vanilla, another of which is plain white bread. These products have neutral flavors. Therefore, it is not inherent that a substance has an identifiable taste associated with it.

Applicant respectfully requests that claims 1 and 5 be allowed.

The Examiner then goes on to discuss claims 2 and 6, and claims 9-12 and 19-22. It is not clear whether or not the Examiner’s discussion is based on a 35 U.S.C. §102 rejection, however, assuming so, Applicant responds thusly:

**Rejection of claims 2 and 6 under 35 U.S.C. §102.**

Rejection of claim 2 under 35 U.S.C. §102 is respectfully traversed for the following reason. Claim 2 is dependent on independent claim 1, which Applicant

believes is unique and not anticipated, and therefore, is in condition for allowance. Therefore the combination of claims 1 and 2 is believed to be unique and not anticipated, and therefore, is in condition for allowance.

Rejection of claim 6 under 35 U.S.C. §102 is respectfully traversed for the following reason. Claim 6 is dependent on claim 5 wherein claim 5 includes the limitation of a second substance being placed on the tongue of the second person prior to the two persons engaging in deep kissing. The Examiner states:

“Guess the Flavor teaches wherein the first substance has an identifiable taste: wherein the second substance has a different identifiable taste that the taste of the first substance. (See Guess the Flavor). It is inherent to the Examiner that to guess the flavor of substances, there has to be identifiable taste associated with the substance.”

Applicant respectfully submits that such statement, while correct, misapplies such statement to the rejection of Applicant's claims. As stated above, claim 5 is clear that the second substance is placed on the tongue of the second person prior to the engaging of deep kissing so that there is a substance on the tongue of each person prior to engaging in deep kissing. It is equally clear in the reading of Guess the Flavor that only one person consumes a substance prior to the two persons engaging in deep kissing. This is clear from the instruction in the reference:

“One team then must leave the room (the 'guessing team'), while the other team remains... this is the 'eating team.' The eating team must then each choose ONE kind of food or candy to eat... and then eat it. Once everyone is done with their treat, the 'guessing team' is let back into the room.”

There is no second substance placed on the tongue of the second person in Guess the Flavor. Guess the flavor cannot anticipate the claims of Applicant. All discussions pertaining to inherency above are pertinent here. In addition, Applicant has shown that claim 5 is unique and not anticipated by the reference. Claim 6 is dependent on independent claim 1, which Applicant believes is unique and not anticipated, and therefore, is in condition for allowance. Therefore the combination of claims 5 and 6 is believed to be unique and not anticipated, and therefore, is in condition for allowance.

Applicant respectfully requests that claims 2 and 6 be allowed.

#### **Rejection of claims 9-12 and 19-22 under 35 U.S.C. §102.**

The Examiner had rejected claims 9-12 and 19-22 under 35 U.S.C. §102. Therefore, each of the claims must be anticipated by the reference. Applicant respectfully traverses such rejection. Applicant has separated each of the statements of the Examiner relevant to this rejection, and will address each statement individually:

1. “Guess the Flavor teaches wherein the instructions direct the first person on placement on the tongue of the first substance prior to the first and second person engaging in deep kissing;”

This is the only statement that truly reflects the teachings of the reference.

2. “wherein the instructions direct the first and second persons on placement on their respective tongues of the first and second substances prior to the first and second persons engaging in deep kissing; “

This statement is not true. The reference does not teach placing a substance of both parties prior to engaging in kissing.

3. “wherein the instructions direct the first and second persons on the selection of tastes of the first and second substances;”

The only statement in the reference is that the “eating team must then teach ONE kind of food or candy to eat, and then eat it.”

4. “herein the instructions identify moods created by the selected tastes and wherein the instructions direct the first and second persons on the selection of the first and second substances to create a selected mood.”

This statement is totally false. There is no mention of the word “mood” in the reference. There is not any discussion of the kind. There is only the discussion of identification of tastes. Applicant respectfully challenges the Examiner to identify in the reference on occurrence of the word “mood,” or any synonyms thereto.

Thus, for the reasons stated above, the cited reference cannot anticipate any of the claims of Applicant’s invention. Claims 9-12 and 19-22 stand allowable on their own.

#### **Rejection of claims 3, 4, 7, 7, 14, 15, 17, and 18 under 35 U.S.C. §103(a).**

The Examiner has rejected claims 3, 4, 7, 8, 14, 15, 17, and 18 under 35 U.S.C. §103 over Guess the Flavor (the cited reference) in view of Applicant’s admitted prior art (AAPA).

The PTO has the burden under section 103 to establish a prima facie case of obviousness. See In re Piasecki , 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. , 776 F.2d 281, 297 n.24, 227 USPQ 657 , 667 n.24 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In order to find claim 1 to be obvious, the Examiner must show that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention was obvious, as stated in In re Bergel, 48 C.C.P.A. 1102, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961); In re Spinnoble, 56 C.C.P.A. 823, 405 F.2d 578, 585, 160 USPQ 237, 244 (CCPA 1969). Therefore, the Examiner must show some objective teaching for the combination of AAPA and the cited reference, Guess the Flavor. Applicant respectfully suggests that the Examiner has not met this burden.

The Examiner states, “Re claims 3, 4, 7 and 8: Guess the flavor teaches the novelty kit containing the first substance and instructions.” Applicant respectfully traverses such statement for the reasons stated above. The cited reference does not teach the provision of a novelty kit.

Secondly, the Examiner states,

“AAPA teaches the kit wherein the first substance is in the form of a solute containing an extract of the first substance; where the solute is water based; wherein the second substance is in the form of a solute containing an extract of the second substance; where the solute is water based (see background of the invention.) Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the combination of the AAPA and Guess the Flavor game so has {sic} to have substances soluble in water and hence soluble in the mouth of the player.

Applicant strongly objects to this line of argument by the Examiner. Such argument is specious. First, there is **no discussions at all** of any type of a kit in the Background of the Invention. The first paragraph, at page 1, lines 8-14, merely describes the history of kissing. Second, the second paragraph, page 1, lines 15-23 describes the method in which tastes are detected in the mouth. Third, the third paragraph, page 1, starting at line 24, discloses the existence of extracts, but then states that “these extracts are concentrated, and are not suitable for the uses contemplated in the invention.”

It should be noted that the first use of the word, “solute” occurs at page 3, line 8, in the Detailed Description of the Invention.

Additionally, the cited reference only describes a parlor game in which one person eats a substance and a second person endeavors to identify such substance through engaging in kissing. There is nothing in the cited reference to suggest that it would be desirable or convenient to use a solute to perform the game. The cited reference teaches one of ordinary skill in the art to purchase candy and/or food items from a store. The cited reference does not teach one of ordinary skill in the art that it would be convenient or beneficial to combine two candy and/or food items so as to create a test sensation.

Therefore, Applicant submits that claims 3, 4, 7, 8, 14, 15, 17, and 18 under 35 U.S.C. §103 are unique and non-obvious as written.

Further, claims 3, 4, 7, 8 are dependant upon independent claim 1, which Applicant believes to be unique and non-obvious, and therefore the combination of claim 1 with claims 3, 4, 7, 8 are believed to be unique and non-obvious. Claims 14, 15, 17, and 18 are dependant upon independent claim 13, which Applicant believes to be unique and non-obvious, and therefore the combination of claim 13 with claims 14, 15, 17, and 18 are believed to be unique and non-obvious.

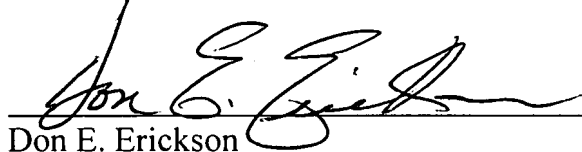
### **Conclusion.**

Applicant has raised more than reasonable doubt that the cited reference was extant more than one year prior to the date of application of Applicant. Applicant has requested that the Examiner provide substantiation of the validity of the cited reference. In addition, Applicant has shown that the cited reference does not anticipate either of the independent claims of Applicant. Applicant has demonstrated that the cited reference does not disclose, either expressly or inherently a kit. Applicant has demonstrated that the cited reference does not disclose, either expressly or inherently a kit containing substances that when placed on one persons tongue, and when the one person engages in

kissing with a second person, a taste sensation is generated. Applicant has demonstrated that the cited reference only described a method by which a particular candy or food item is identified.

Applicant respectfully requests that all of Applicant's claims be allowed.

Respectfully submitted,



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